UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,841	04/10/2001	Takayuki Sugiura	1466.1036	7530

21171	7590	06/30/2005

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
2626	

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/828,841	SUGIURA ET AL.
	Examiner	**Art Unit**	
	Saeid Ebrahimi-dehKordy	2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 February 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-16* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *9, 11 and 15* is/are allowed.

6)☒ Claim(s) *1, 3-7, 10 and 12-14* is/are rejected.

7)☒ Claim(s) *8* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Response to Amendment

1.   Applicant's arguments with respect to claim 1-16 have been considered but are moot in

view of the new ground(s) of rejection.

Applicant argues that the header contains the printer information, which lacks on Teng et al.

Examiner although disagrees with the Applicant, points out that Wood et al on column 5 lines

62-67 and column 6 lines 1-8 teach the where the specific printer is designated by the ID or

identification to be used when transmitting print job to the printer.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   Claim 1, 3-6 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Teng et al (U.S. patent 6,327,045) in view of Wood et al (U.S. patent 6,453,127)

Regarding claim 1 Teng et al disclose: A print control method for transmitting

print data from a client to a print server managing a printer so as to print by the printer in

a network environment (please note Fig.1, column 5 lines 43-54) the method comprising

the steps of: using HTTP as a communication protocol between the client and the print

server (please note column 6 lines 63-67 and column 7 lines 1-8) in the client (please

note Fig.2 item 20 the client, column 6 lines 22-23) adding a header including

information about the printer to be used to the print data so as to transmit the print data

(please note column 6 lines 24-57 also column 6 lines 43-63) in the print server (please

note Fig.2 item 49, column 6 lines 64-67) receiving the print data and transmitting the

print data to the printer in accordance with the header of the print data (please note

Fig.2, column 6 lines 63-67 and column 7 lines 1-5) and in the printer printing the print

data (please note column 7 lines 6-9) However Teng et al do not disclose: and in the

print server, converting a result of the printing or information about the printer into a

hypertext and transmitting the result or the information to the client On the other hand

Wood et al disclose: and in the print server (note Fig.2 item 30 which in this case would be

used as also print server the way it stores and routes print job from the client 11 to the

printer 15, as most of the print server do this function) converting a result of the printing or

information about the printer into a hypertext and transmitting the result or the information

to the client (note Fig.2 item 15 the printer where the results of the printing data is and error

message is generated and through the Bus 26 is send back to the sever 30 and form then

on to the user at workstation 11 through the TCP/IP or HTTP which both are used in this

case , "note wood column 4 lines 45-56" and note Fig.2 item 18 the HTTP connection

between the user and server 30, column 6 lines 55-65). Therefore it would have been

obvious to a person of ordinary skill in art at the time of the invention to modify Teng et

al's invention according to the teaching of Wood et al, Where Wood et al in the same

filed of endeavor teach the way the result of the printing information is transmitted back

through the server and protocols to the client for the purpose of notifying the client as

the status of the job and printer.

Regarding claim 3 Teng et al disclose: The print control method according to claim 2, wherein the transmitting step includes the step of removing the header of the print data in the print server before transmitting the print data to the printer (please note Fig.4 items 94 and 96, column 7 lines 1-8 and also column 10 lines 5-10).

Regarding claim 4 Teng et al disclose: The print control method according to claim 2, further comprising the steps of monitoring the state of the printer and generating a hypertext describing the state of the printer in the print server (please note column 8 lines 30-40).

Regarding claim 5 Teng et al disclose: The print control method according to claim 2, further comprising the steps of memorizing printer information such as an address a type and a protocol of the printer for each printer and generating the hypertext describing the printer information in the print server (please note column 8 lines 10-33).

Regarding claim 6 Teng et al disclose: The print control method according to claim 2, further comprising the steps of memorizing the printer information in the printer and acquiring the printer information using SNMP as a communication protocol so as to monitor the state of the printer in the print server (please note column 6 lines 44-55).

Regarding claim 13 Wood et al disclose: The print control method according to claim 1, wherein the adding of the header comprises adding a header including information about a printer location the method further comprising: generating information about the communication protocol in the print server (note column 5 lines 61-67 and column 6 lines 1-8).

Regarding claim 14 Wood et al disclose: The print control method according to claim

1, further comprising: generating a hypertext describing printer registration information in

the printer server; and registering the printer in a terminal device of the client according to

the generated printer registration information (note column 6 lines 2-8).

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al (U.S.

patent 6,453,127) in view of Soga (U.S. patent 6,476,938)

Regarding claim 7 Wood et al disclose: A print server for managing a printer in a

network environment (note Fig.2 item 30 which in this case would be used as also print

server the way it stores and routes print job from the client 11 to the printer 15, as most

of the print server do this function as explained the way the server 30 manages the

printer 15 by transmitting the data to the printer and sending back the results of the

printing to the client 11, column 6 lines 40-65) comprising: a HTTP receiving means for

receiving print data using HTTP as a communication protocol (note Fig.2 item 32 where

the client 11 communicating through the HTTP protocol with the web server 18, column

5 lines 62-67 and column 6 lines 1-2) a print data transmitting means for transmitting the

print data to a printer as an output target in accordance with a HTTP header of the print

data (note Fig.2 item 33 the marking engine which transmits the print job to the printer 15, column 6 lines 51-45 and note column 5 lines 61-67 and column 6 lines 1-8 where the HTTP protocol is used to identify and ID the printer) However Wood et al do not disclose: a PDL converting unit that fudges whether the print data is an appropriate PDL file for printing in the printer, and converts the print data into the appropriate PDL file corresponding to the printer when the print data is not the appropriate PDL file for printing in the printer. On the other hand Soga discloses: a PDL converting unit that judges whether the print data is an appropriate PDL file for printing in the printer (note Soga, Fig.1 items 108 and 110 which in combination act as the converter for PDL data, to first convert the DPA data to PDL and then in combination with the interpreter 110 interpret the PDL data to fit the printer's need, column 4 lines 35-53) and converts the print data into the appropriate PDL file corresponding to the printer when the print data is not the appropriate PDL file for printing in the printer (note column 5 lines 6-37 where the interpreter 110 interprets the data to be used by printer 40). Therefore it would have been obvious to a person of ordinary skill in art at the time of the invention to modify Wood et al's invention according to the teaching of Soga, Where Soga teaches the way the pdl data is interpreted and formatted for the purpose of making it usable by the printer.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7.   Claim 10 and 12 rejected under 35 U.S.C. 102(e) as being anticipated by Wood et al

(U.S. patent 6,453,127)

Regarding claim 10 Wood et al disclose: A recording medium that can be read by

a computer having a WWW server function (please note Fig.2 item item 30 the

computer and item 32 the web server) the recording medium storing a program

comprising the steps of using HTTP as a communication protocol so as to receive print

data from a client (note Fig.2 item 18 the HTTP protocol and column 6 lines 34-45

where the print data is transmitted to the server and thereon to the printer 15) and

transmitting the print data to a printer designated by the client (please note Fig.2 items

30 and 15, column 5 lines 61-67 and column 7 lines 1-8 where the printer is selected by

it's ID and the print job is transmitted to that printer).

Regarding claim 12 Wood et al disclose; A print control method comprising:

receiving print data using HTTP (note Fig.2 item 18 HTTP protocol transmitting data

through HTTP to the web server of server 30, column 6 lines 34-45) and adding a

header including information about a printer to receive print data (note Fig.2, column 5

lines 62-67 and column 7 lines 1-8 where the information of the printer is added like the

ID of the printer).

Allowable Subject Matter

8.   Claim 9,11 and 15 are allowed.

The prior art of record fails to disclose the limitation of another header being added based on the communication protocol when the communication protocol is changed.

9.   Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As claim 8 adds new limitation including the first hypertext and second hypertext-generating unit.

Conclusion

10.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

➤ Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (571) 272-7462.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (571) 272-7471.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(571) 273-8300, (for *formal* communications; please mark
"EXPEDITED PROCEDURE")

Or:

(703) 306-5406 (for *informal* or *draft* communications, please label
"PROPOSED" or "DRAFT")

Hand delivered responses should be brought to Knox building on 501 Dulany Street, Alexandria, VA.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy
Patent Examiner
Group Art Unit 2626
June 24, 2005

KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER